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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/516,667

08/16/2005

Wilhelm Paul Wolf

20496-469

8758

21890

7590

10/01/2008

PROSKAUER ROSE LLP  
PATENT DEPARTMENT  
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NEW YORK, NY 10036-8299

EXAMINER

KURTZ, BENJAMIN M

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

10/01/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/516,667	<b>Applicant(s)</b> WOLF ET AL.	
	<b>Examiner</b> BENJAMIN KURTZ	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7/30/08.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

Claims 1-10 are currently pending.

### ***Information Disclosure Statement***

1. The information disclosure statement filed 7/30/08 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Rejections - 35 USC § 102 and 103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**2. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Firth US 3 847 819.**

Regarding claim 1, Firth teaches a device comprising an inlet opening (27), an outlet opening (25) and a metal housing (10a) enclosing a filter chamber, and having a service opening closed by means of a first lid (17), also of metal, which is seated on a rim portion (10b) surrounding the service opening in direct contact with the metal of the housing, a rim surface of the rim portion associated with the first lid sloping between an inner boundary edge that is that is associated with the service opening and an outer boundary edge such that the rim surface forms an angle deviating from 90 degrees with an adjacent inside surface and outside surface of the rim portion and a sealing contact surface obtained between the first lid and the rim portion is substantially linear, and wherein there is arranged inside the filter chamber a filter element (20) (fig. 1 and 3, col. 6, lines 24-44).

Regarding claims 2-8, Firth further teaches the filter element is a filter body which is seated on a wall that defines the filter chamber and through which the fluid can flow in a region of at least one peripheral surface of the filter element (fig. 1); a sealing surface (23) of the filter element surrounds the outlet opening (fig. 1); the filter element is biased by resilient force acting from the filter chamber on a sealing surface (fig. 1); the filter element is cylindrical in shape (fig. 1); the metal housing is tubular and service openings (upper end and (12)) are formed on end faces of the metal housing (fig. 1); the housing

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is tubular (fig. 1); and the first lid and a second lid (17 and the cap of element (13)) are mutually tensioned (fig. 1).

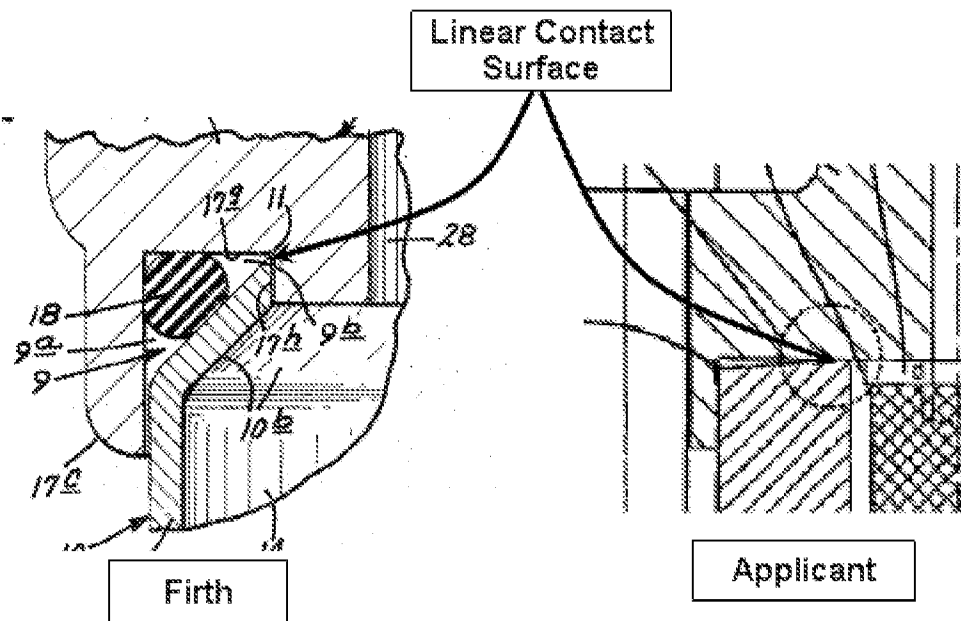
**3. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Firth in view of Hemmingsen US 1 802 423.**

Firth teaches the device of claim 8 but does not teach the tensioning is obtained by tension screws or tension bolts or the inlet being formed in the first lid and the outlet being formed in the second lid

Hemmingsen teaches a device having an inlet opening formed in a first lid and an outlet opening formed in a second lid with a housing body located between the two lids and the first and second lids are mutually tensioned by tension bolts (fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the second lid design of Hemmingsen, incorporating the second lid containing an outlet and the tensioning screws, because it allows the filter to be oriented in a straight line system. Also, the claims would have been obvious because the particular known technique, of having the inlet and outlet at opposite ends of the housing and using tensioning screws, was recognized as part of the ordinary capabilities of one skilled in the art, *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007).

***Response to Arguments***

Applicant's arguments filed 7/30/08 have been fully considered but they are not persuasive. Applicant argues that Firth does not teach a rim portion and a lid that form a substantially linear sealing contact surface. Firth teaches the rim forms a seal with the lid (col. 6, lines 30-35). The rim forms some sealing, and therefore is in sealing contact. The language of applicant's claim allows for additional sealing elements to be present. The rim forms a linear contact surface with the lid in the same way depicted by the applicant and it is unclear from applicant's arguments how the two contact surfaces are different.



### **Conclusion**

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN KURTZ whose telephone number is (571)272-8211. The examiner can normally be reached on Monday through Friday 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Benjamin Kurtz  
Examiner  
Art Unit 1797

/Benjamin Kurtz/  
Examiner, Art Unit 1797  
9/24/08

/Krishnan S Menon/  
Primary Examiner, Art Unit 1797